

REMARKS

As a preliminary matter, Applicants note that Claim 3 was cancelled in Amendment A, without prejudice, and Claims 10, 19 and 20 are being cancelled, without prejudice, in this amendment. Thus, Claims 1, 2, 4-9, 11-18, 21 and 22 are currently pending.

Claims 9, 13-15 and 21 stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 6,692,530 to Doubler et al. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Doubler et al. reference fails to disclose all of the features of the present invention. More specifically, the Doubler et al. reference fails to disclose a modular hip prosthesis that includes, *inter alia*, a proximal body that is “positioned around the stem,” as now defined in amended independent Claim 9.

One example of an embodiment of the prosthesis defined in independent Claim 9 is shown in Applicants’ Figures 1 and 2, which embodiment includes proximal body 14 and stem 12. In this embodiment, the proximal body includes a bore 86 (Figure 6B) so that it can be positioned around the stem 12, as shown in Applicants’ Figure 2.

In the device of Doubler et al., the Examiner equated jack screw 20 of Figures 1 and 4-6 with the claimed proximal body, and he equated rod 11 with the claimed stem. *See* July 5, 2006 Office Action, page 2, paragraph 4. As can be seen in Figure 1a of the Doubler et al. reference, member 20 is positioned within member 11. Accordingly, member 20 cannot be considered as the claimed proximal body of independent Claim 9 because it is not

“positioned around the stem,” as defined in amended independent Claim 9. Accordingly, for at least this reason, Applicants respectfully request the withdrawal of this §102(b) rejection of independent Claim 9 and associated dependent Claims 13-15 and 21.

Further, Applicants also separately traverse this §102(b) rejection under Doubler et al. because the Doubler et al. reference fails to disclose that the proximal body includes “a threaded section located along an internal longitudinal bore.” Applicant’s Figure 6B shows one example of a proximal body (14) that includes threaded section 92 along an internal longitudinal bore 86, as now recited in independent Claim 9. In contrast, in the device of Doubler et al., jack screw 20 includes a threaded section 51 on an external surface (see Figure 1A), and therefore lacks a threaded section on an internal bore, as defined in Claim 9. Accordingly, for this reason also, Applicants respectfully request the withdrawal of this §102(b) rejection of independent Claim 9 and associated dependent Claims 13-15 and 21 under Doubler et al.

Claims 9 and 13-22 stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 6,428,578 to White. Claims 19 and 20 have been cancelled, without prejudice, thereby rendering this rejection moot with respect to these claims. However, with respect to Claims 9, 13-18, 21 and 22, Applicants respectfully traverse this rejection.

Applicants respectfully submit that the cited reference fails to disclose all of the features of the present invention. More specifically, the White reference fails to disclose a modular hip prosthesis that includes, *inter alia*, a proximal body that “includes a threaded

section located along an internal longitudinal bore” and a locking member that “engages the threaded section,” as defined in amended independent Claim 9. In the July 5, 2006 Office Action, on pages 3 and 4, paragraph 6, the Examiner equated body 14 of White with the claimed “proximal body” and he equated each of the following components of White with the claimed locking member: (a) upper shoulder 38; (b) the countersunk inlet disclosed in column 6 of White; and (c) the upper sleeve 17 of Figure 7 of White. However, as can be seen from a review of the White reference, body 14 does not include the claimed “threaded section” of Claim 9. Further, there is no portion that “engages the threaded section” in any of the components of White that the Examiner equated with the locking member defined in Claim 9. Accordingly, for at least these reasons, Applicants respectfully request the withdrawal of this §102(e) rejection of independent Claim 9 and associated dependent Claims 13-15 and 21 under White.

With regard to independent Claim 16, Applicants respectfully submit that the White reference fails to disclose a modular hip prosthesis that includes, *inter alia*, a neck that includes “a bore that receives the proximal end of the stem.” One example of an embodiment of the present invention that includes such a neck with a bore is shown in Figures 1 and 4B, which show neck 16 with bore 60 that receives the proximal end of the stem 12 (where Figure 3A also shows the proximal end 36 of the stem 12).

In contrast, as can be seen in Figure 6 of the White reference, neck 22 does not include a bore that receives a proximal end of the stem 30. Instead of including a bore, neck 22 includes a protrusion 27. Further, protrusion 27 is configured to be received within sleeve

16, and is not configured to mate with stem 30. Accordingly, for at least these reasons, Applicants respectfully request the withdrawal of this §102(e) rejection of independent Claim 16 and associated dependent Claims 17-20 and 22.

Claims 9, 13-18 and 21 stand rejected under 35 U.S.C. §102(e) as being anticipated by United States Patent Application Publication No. 204/0122525 to Daniels et al. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Daniels et al. reference fails to disclose all of the features of the present invention. More specifically, the Daniels et al. reference fails to disclose a modular hip prosthesis that includes, *inter alia*, a proximal body that “includes a threaded section located along an internal longitudinal bore, and [wherein] the locking member engages the threaded section,” as defined in independent Claim 9. Further, with regard to independent Claim 16, the Daniels et al. reference fails to disclose a sleeve that is “radially flexible and includes a plurality of longitudinal slots.”

With regard to independent Claim 9, one example of an embodiment that includes the claimed proximal body with a threaded section located along an internal bore is shown in Figures 1 and 6B, as represented by proximal body 14 with threaded section 92. Figures 1 and 2 show how locking member 20 engages the threaded section of proximal body 14.

In contrast, none of the Examiner’s interpretations of the claimed proximal body include the claimed threaded section located along an internal longitudinal bore, as defined in independent Claim 9. More specifically, the Examiner’s first interpretation

defines the proximal body as sleeve 14 (such as in Figures 1 and 4 of Daniels et al.). However, sleeve 14 fails to include the claimed threaded section. The Examiner's second interpretation defines the proximal body as keyed component 94 and interdigitating component 106, such as in Figure 11. However, neither the keyed component nor the interdigitating component includes the claimed threaded section. The Examiner's third interpretation of the proximal body combines the components of the first two interpretations. As mentioned above, none of the components of the first two interpretations include the claimed threaded section. Thus, combining the components of the first two interpretations into a third interpretation still lacks the claimed threaded section of Claim 9. Accordingly, as all of the features of independent Claim 9a are not disclosed in the Daniels et al. reference, Applicants respectfully request the withdrawal of this §102(e) rejection of independent Claim 9 and associated dependent Claims 13-15 and 21.

With regard to independent Claim 16, Applicants respectfully submit that member 90 of Daniels et al., or even the distal portion thereof, is not "radially flexible," nor does it include "a plurality of longitudinal slots." One example of an embodiment of the sleeve of Claim 16 is shown in Applicants' Figure 7A, which shows sleeve 18 with longitudinal slots 108. Accordingly, as all of the features of Claim 16 are not disclosed in the Daniels et al. reference, Applicants respectfully request the withdrawal of this §102(e) rejection of independent Claims 16 and associated dependent Claims 17, 18 and 22.

Claims 1-8 and 10-12 stand rejected under 35 U.S.C. §103 as being unpatentable over United States Patent No. 6,428,578 to White in view of United States

Patent No. 5,755,800 to O'Neil et al. As mentioned above, Claim 3 was cancelled in Amendment A, without prejudice. Accordingly, this rejection has been rendered moot with respect to Claim 3. However, with respect to the other claims, Applicants respectfully traverse this rejection.

As a preliminary matter, Applicants note that the subject matter of dependent Claim 10 has now been incorporated into independent Claim 9. Accordingly, Applicants will respond as though the rejection included Claim 9.

Applicants respectfully submit that one of ordinary skill in the art would not have modified the device of the White reference in light of the O'Neil et al. reference because of the differences in the types of components described in each reference. The White reference relates to a hip prosthesis, while the O'Neil et al. reference relates to a knee joint prosthesis. The securement device 90 of O'Neil et al. is used for fixing an augmentation block 84 to an articulation member 14 of a knee joint prosthesis. In contrast, the hip prosthesis of the White reference fails to include an augmentation block or an articulation member. Further, the components of the White reference already include a means of being attached together, i.e., by applying an axial force to sleeve 16. Accordingly, since the components being attached together in O'Neil et al. are different from those being attached together in White, and also because the White device already includes a connector mechanism for attaching the components together, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to add the securement device of

O'Neil et al. to the device of White. Therefore, Applicants respectfully request the withdrawal of this §103 rejection of independent Claims 1, 2, 4-9, 11 and 12.

Additionally, even assuming *arguendo* that White and O'Neil et al. could be combined, Applicants respectfully submit that the proposed combination of White and O'Neil et al. fails to disclose or suggest all of the features defined in independent Claim 1. More specifically, even assuming *arguendo* that White and O'Neil et al. could be combined, the proposed combination still lacks a flexible sleeve that is "seated axially adjacent the expansible collet" as defined in independent Claim 1.

In the July 5, 2006 Office Action, the Examiner correctly acknowledged that the White et al. reference fails to disclose that the locking member includes threads that engage a threaded section of the proximal body. Accordingly, the Examiner relied upon the O'Neil et al. reference for this feature. However, even assuming *arguendo* that the Examiner could combine White and O'Neil et al., the proposed combination still lacks the feature of Claim 1 that recites that "the locking member is seated axially adjacent the expansible collet." One example of an embodiment of Applicants' invention of Claim 1 that includes this feature is shown in Figure 2, where it can be seen that locking member 20 is axially adjacent expansible collet 18.

In contrast, in the O'Neil et al. reference, the features that most closely resemble the claimed locking member and the claimed expansible collet are not *axially* adjacent to each other, but are instead *radially* adjacent to each other. More specifically, Figures 5 and 7 of O'Neil et al. show securement device 90 (which the Examiner equated


with the claimed "locking member") and compression collet 88 (which the Examiner equated with the claimed "expansible collet"). As can best be seen in Figure 7 of O'Neil et al., securement device 90 is not *axially* adjacent compression collet 88, but is instead *radially* adjacent compression collet 88. Accordingly, all of the features of independent Claim 1 are not disclosed or suggested in the cited references. Therefore, Applicants respectfully request the withdrawal of this §103 rejection of independent Claim 1 and associated dependent Claims 2 and 4-8 for this reason also.

Finally, Applicants have also added new dependent Claims 23 and 24. Applicants respectfully submit that new dependent Claims 23 and 24 are allowable for at least the reasons discussed above with respect to their associated independent claims.

For all of the above reasons, Applicants request reconsideration and allowance of the claimed invention. Should the Examiner be of the opinion that a telephone conference would aid in the prosecution of the application, or that outstanding issues exist, the Examiner is invited to contact the undersigned.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By 
James K. Folker
Registration No. 37,538

July 21, 2006
Suite 2500
300 South Wacker Drive
Chicago, Illinois 60606
(312) 360-0080
Customer No. 48844
P:\DOCS\2602\73747\AG7694.DOC